

Appl. No. 10/004,115  
Amdt. dated February 6, 2004  
Reply to Office Action of November 19, 2003

#### REMARKS

Please enter this Amendment, the separately filed replacement Oath/Declaration, the to be separately filed correction to SEQ ID NO: 34 and SEQ ID NO: 35, and then favorably reconsider all objections and rejections.

The submitted replacement Oath/Declaration corrected the spelling of the fourth named inventor. It was transliterated as Ito wherein fact it ought to have been Itoh.

The to be separately filed document submitting corrected SEQ ID NO is thought to be straightforward in view of the MPEP 2100, such as pages 157-158, Rev. 1, Feb. 2003) and the pre-application deposit under FERM P-18127, later renamed as FERM BP-7752.

#### Claim Amendments

The amended and new claims find support in the original specification. Amended claim 1 is supported at, for instance, pages 4-5, 8-9 and 11. Amended claims 4, 8, 16, 17, 18, 19, 20 and 26-37 include changing "claim" to "Claim" solely for consistency. The spelling of 4-cyano-3-hydroxybutanoic acid has been corrected in claims 28-30. Amended claim 31 presents the corrected spelling of an enantiomer. New claims 39-40 find basis in the original specification and the original claims. Claim 10 has been cancelled.

The requirement for restriction is acknowledged, as is the initial decision declining reconsideration. It is respectfully requested that the Examiner reconsider. The point is not whether this case is a PCT or the like, but rather whether a predicate for imposing the requirement for restriction has been undercut for the reasons of record. The Examiner's hypothesis about what the late Judge Rich and the late P J. Federico may have intended with 35 U.S.C §121 is noted, but plain meaning of the statute does not support the restriction as worded. In the alternative, Applicants request re-joinder.

Appl. No. 10/004,115  
Amdt. dated February 6, 2004  
Reply to Office Action of November 19, 2003

### **Claims Objections**

The Examiner objected to claims 3-7, 12 and 13 under 37 C.F.R. 1.75(c). The Examiner did, however, consider the claims on the merits in the interest of compact prosecution, which Applicants acknowledge with appreciation. Applicants have presented amendments to overcome this objection and added new claims 39-41 so that claim scope is not surrendered. Please reconsider and withdraw this objection.

The Examiner suggested Applicants use a consistent term, protein or enzyme, in claims 1 and 9-14. The amended claims address this recommendation without surrendering claim scope.

### **35 U.S.C. §112 (¶1) - The Claims are Supported**

The Examiner interposed two rejections. Claims 9-14 were rejected under 35 U.S.C. §112 (¶1) as containing subject matter which allegedly was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time their application was filed, had possession of the claimed inventions. Claims 1(b) and claims 2-14 were also rejected for the reasons stated at pages 6-9 of the Office Action.

Applicants traverse both rejections.

Claim 9 and claim 14 find support in the original specification throughout, including Examples 2 and 3 (page 64). It will be appreciated that a commercially available glucose dehydrogenase is disclosed, and such an enzyme is recited in claims 9 and 14.

New claims 40 and 41 recite a glucose dehydrogenase derived from a *Bacillus megaterium*.

Appl. No. 10/004,115  
Amdt. dated February 6, 2004  
Reply to Office Action of November 19, 2003

Claims 1(b) and 2-14 similarly find support in the original specification throughout. Stringent conditions or their equivalents disclosed support the claims. The Examiner is respectfully directed to page 4, last paragraph for claim 1(b). The Examiner should separately note, unrelated to the rejection being traversed, page 11, last paragraph for claim 1(d); and page 8 bridging to page 9 for claim 1(f).

**35 U.S.C. §101**

The Examiner rejected claim 1 for reciting "polynucleotide." The rejection should be reconsidered and withdrawn in view of the claim amendments. The amendment is not intended to restrict claim scope against equivalents to the claimed invention.

**Other Matters Co-pending Applications**

The Examiner may wish to note commonly assigned co-pending applications, including 10/327,108 filed December 24, 2002, T/C 1633; and 09/984,334 filed October 29, 2001, T/C 1626.

Applicants respectfully solicit an early favorable action on the merits.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: 

Kendrew H. Colton  
Registration No. 30,368

Fitch, Even, Tabin & Flannery  
1801 K Street, N.W., Suite 401L  
Washington, D.C. 20006-1201  
Telephone No. (202) 419-7000  
Facsimile No. (202) 419-7007